

REMARKS

Claims 1-4, 10-12 and 24 have been amended to correct grammatical errors and to make clarifying changes which more clearly recite the claim elements without narrowing the scope of the claims. Claims 25-27 have been added. Claims 1-27 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested. Support for the amendments is found in the original claims, Specification, and Drawings.

New claim 25 recites subject matter found in original claim 16.

New claim 26 depends from claim 25 and recites subject matter found in original claim 6.

New claim 27 depends from claim 26.

New claims 25-27 recite subject matter found in the specifications and the original claims and are allowable for at least for the same reasons discussed below with respect to claims 1 and 16.

The Pending Claims Are Not Obvious in View of the Applied Art

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee, U.S. Patent Application Publication No. 2003/0121973 in view of Mariotti, U.S. patent no. 1,924,365.

These rejections are respectfully traversed.

The Applied Reference Does Not Disclose or Suggest the Features and Relationships Recited in Applicants' Claims

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are

known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

**The Pending Claims Are Not Obvious Over
Lee in view of Mariotti**

In the Action claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Mariotti. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretation of Lee and Mariotti. Thus,

any change in the Office's interpretation of these references shall constitute a new ground of rejection.

The claims are directed to a cash dispensing automated banking machine and a method involving an automated banking machine. The Action asserts that Lee shows an ATM machine with a casing (10) with an interior portion (reservoir alleged at paragraph [0027]), and a lockable door (20) with a sliding portion (paragraph [0029]). The Action further asserts that Official Notice is taken that means to allow media to be input into an ATM is old and well known. The Action then argues that "it would have been obvious . . . to include a media input means in the ATM of Lee to allow for customer deposits."

In addition, the Action acknowledges that Lee does not disclose a key locking mechanism. However, the Action asserts that Mariotti discloses a housing with an interior portion, reservoir, and a sliding door which is locked by means of a key. The Action then states that "it would have been obvious . . . to use a key lock on the ATM of Lee. This would provide for a positive mechanical lock on the door hindering any attempt to physically pry open the door.

Applicants respectfully disagree with these assertions. For example, Lee is directed to a media dispenser module for an ATM that has a locking mechanism (described in paragraphs [0035] and [0039] for a first embodiment and in paragraph [0056] to [0059] for a second embodiment). There is no teaching, suggestion, or motivation to include a key lock on the door (20) in addition to the described "secure locking mechanism". Further, the addition of such a key lock would defeat the utility or advantages of Lee's invention. The ATM is designed to automatically slide down (open) the door (20) when media requested by the user is piled on the media mounting portion (12) (Figure 1, paragraphs [0033] to [0036]. Placing a key lock on the

door would require each user to have a key. Nowhere do Lee or Mariotti disclose or suggest ATMs which require a physical key to access cash dispensed by the ATMs. Further, providing physical keys to users of the ATM would defeat the alleged security provided by a key lock, because everyone (including thieves) could have a copy of the key. Although Mariotti discloses a key lock 38, the key of Mariotti is intended to only be used by authorized persons (Column 1, line 10). Neither Lee nor Mariotti discloses or suggests providing an ATM or a vault with a key lock usable by the general public to access dispensed cash.

Thus it would not be obvious to combine Lee with Mariotti as suggested. Further, even if there were a prior art teaching or suggestion to combine Lee and Mariotti as suggested, the claims are not directed to a consumer accessible dispensing mechanism which includes a keylock. Rather the claims are directed to unique features and operation of a deposit holding container which slides in supporting connection with a bracket inside a secure chest of an automated banking machine. Thus the suggested combination of features in Lee and Mariotti does not correspond to the features recited in Applicants' claims.

Further, if there were a prior art teaching or suggestion to combine Lee and Mariotti (which there is not), at best such a combination would only produce an ATM with a vault that includes a key usable to both lock and unlock the vault. However, this hypothetical combination does not correspond to the specific features and/or steps associated with the deposit holding container recited in the claims. As is discussed below in more detail, each of the claims recites features, relationships, and/or steps which are not disclosed or suggested by such a hypothetical combination of features of Lee and Mariotti.

Claim 1

Claim 1 is an independent claim directed to a cash dispensing automated banking machine. Neither Lee nor Mariotti disclose or suggest the following features recited in claim 1:

- a bracket in operative connection with an inner portion of the chest;
- a deposit holding container movably engageable with the bracket;
- the container comprises . . . a locking mechanism;
- the locking mechanism being operative to change from a locked state to an armed state responsive to a key;
- the locking mechanism including a movable portion, wherein when the movable portion is moved, the locking mechanism is operative to change from an armed state to a locked state;
- a door in operative connection with the reservoir, wherein when the locking mechanism is in the armed state, the door is moveable from a closed position to an open position;
- when the container is moved into engagement with the bracket a first portion of the machine being operative to urge the movable portion of the container to place the locking mechanism in a locked state;
- when the container is moved out of engagement with the bracket a second portion of the machine being operative to urge the door of the container to move from the open position to the closed position, and in the closed position, a portion of the door being operatively engaged with the locking mechanism, and with the door

engaged with the locking mechanism in the locked state the door is thereafter prevented from moving to an open position.

In addition to not disclosing or suggesting these features, the cited art teaches away from these recited features. For example, Mariotti specifically teaches that the key must be used to lock the door in the closed position (Page 2, lines 69-80). Claim 1 does not recite a locking mechanism which operates in this manner. Rather, the key is used to place the locking mechanism in an armed state not a locked state. This container in the armed state may then be engaged with the bracket inside the chest of the automated banking machine. In the armed state, the door of the container is capable of moving from a closed position to an open position (if needed) so that deposited items may be placed into the container through operation of an accepting device.

As the container moves in engagement with the bracket, a first portion of the machine urges a movable portion on the container to move which causes the locking mechanism to change from an armed state to a locked state. Then as the container is removed and moves out of engagement with the bracket, a second portion of the machine is operative to urge the door of the container to move from the open position to the closed position. Movement of the door to the closed position engages the door and the locking mechanism in the locked state, and the locking mechanism prevents the door from moving to an open position. Neither reference discloses or suggests a door of a deposit holding container that is locked in a closed position by moving the container into and out of engagement with a bracket inside a chest of an automated banking machine.

In use, a person retrieving the container from the automated banking machine does not require access to a key to the container to close and lock it. Rather, the configuration of the exemplary machine as recited in claim 1 automatically closes and locks the container when it is removed from the chest. Thus the person removing a full deposit holding container from the automated banking machine can transport the container in a locked state without the need to provide this person with a key to the container. Neither reference discloses or suggests a deposit holding container in an automated banking machine with these features. Rather, Mariotti teaches away from these features by requiring a key to be used to lock the door in the closed position (Page 2, lines 69-80).

A reference teaching away from the recited invention does not support *prima facie* obviousness. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine* 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Thus with respect to claim 1, neither reference discloses or suggests a locking mechanism on a deposit holding container that is operative to change from a locked state to an armed state responsive to a key, wherein the door is moveable from a closed position to an open position in the armed state and the door. In addition, neither reference discloses or suggests that when the container is moved into engagement with the bracket a first portion of the machine is operative to urge the movable portion of the container to move which causes the locking mechanism to change from an armed state to a locked state. In addition, neither reference discloses or suggests that when the container is moved out of engagement with the bracket a second portion of the machine is operative to urge the door of the container to move from

the open position to the closed position which engages the door with the locking mechanism (in the locked state) and prevents the door from moving to an open position.

The applied references do not disclose or suggest each of features and relationships recited in the claim, and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 1 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 2-15 which depend from claim 1 are likewise allowable.

Claim 16

Claim 16 is an independent claim directed to a method. Neither Lee nor Mariotti discloses or suggests the following features, relationships and steps recited in claim 16:

- urging a deposit holding container to slide adjacent a bracket of an automated banking machine . . . wherein the locking mechanism (included with the container) is in an armed state,
- the door (of the container) being operative to move from a closed position to an open position when the locking mechanism is in the armed state;

- urging with a first portion of the automated banking machine the locking mechanism to change to a locked state responsive to (urging the container to slide adjacent a bracket of the machine);
- urging with a second portion of the automated banking machine, the door of the container to move to a closed position responsive to (urging the container to slide out of the bracket), wherein a portion of the door engages with the locking mechanism, wherein the locking mechanism in the locked state is operative to prevent the door from moving to an open position.

In addition to not disclosing or suggesting these features, relationships and steps, the cited art teaches away from these recited features, relationships and steps. For example, Mariotti specifically teaches that the key must be used to lock the door in the closed position (Page 2, lines 69-80). Claim 16 does not recite a method in which a locking mechanism is operated in this manner. Rather, as recited in claim 16, a first portion of the automated banking machine urges the locking mechanism to change to from an armed state to a locked state responsive to a step of urging the container to slide adjacent a bracket of the machine. Then a second portion of the automated banking machine urges the door of the container to move to a closed position responsive to a step of urging the container to slide out of the bracket. This causes the door to engage with the locking mechanism in the locked state and prevents the door from moving to an open position. Neither reference discloses or suggests a portion of a banking machine that changes a state of a lock as a deposit holding container is installed in a banking machine, and a

door of a deposit holding container that is locked in a closed position by urging the container into and out of engagement with a bracket inside a chest of an automated banking machine.

As discussed previously, with this recited method, a person retrieving the container from the automated banking machine does not require access to a key to the container to close and lock it. Rather, the operation of the machine as recited in claim 16 automatically closes and locks the container when it is removed. Thus the person removing a full deposit holding container from the automated banking machine can transport the container in a locked state without the need to provide this person with a key to the container. Neither reference discloses or suggests that its respective ATMs or vaults are operated in this manner. Rather, Mariotti teaches away from these steps by requiring a key to be used to lock the door in the closed position (Page 2, lines 69-80).

A reference teaching away from the recited invention does not support *prima facie* obviousness. It is improper to reconstruct the invention from prior art features based upon the disclosure of the Applicants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine* 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Thus with respect to claim 16, neither reference discloses or suggests: urging a deposit holding container with a locking mechanism in an armed state to slide adjacent a bracket of an automated banking machine. Further, neither reference discloses or suggests that a door of the container is operative to move from a closed position to an open position when the locking mechanism is in the armed state. In addition, neither reference discloses or suggests urging with a first portion of the automated banking machine the locking mechanism to change to a

locked state responsive to urging the container to slide adjacent a bracket of the machine.

Further, neither reference discloses or suggests **urging, with a second portion of the automated banking machine, the door of the container to move to a closed position responsive to urging the container to slide out of the bracket.** Also, neither reference discloses or suggests that in the step of urging the container to slide out of the bracket, **a portion of the door engages with the locking mechanism, wherein the locking mechanism in the locked state is operative to prevent the door from moving to an open position.**

The applied references do not disclose or suggest each of the features, relationships, and steps recited in claim and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features, relationships, and steps that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 16 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 17-23 which depend from claim 16 are likewise allowable.

Claim 24

Claim 24 is an independent claim directed to a cash dispensing automated banking machine. Neither Lee nor Mariotti discloses or suggests the following features recited in claim 24:

- a chest in operative connection with a frame, wherein the chest has a generally "L" shaped outer contour with a first taller portion adjacent a second relatively shorter portion;

- the shorter portion including an upper face with an opening therethrough;
- a cash dispenser in operative connection within the taller portion of the chest;
- an acceptor device in operative connection with an outer portion of the chest;
- wherein the acceptor device is positioned above the shorter portion;
- wherein the acceptor device is positioned . . . adjacent to the first taller portion;
- a deposit holding container in removable connection within the shorter portion of the chest;
- wherein the acceptor device is operative to move items through the opening into the container.

Neither Lee nor Mariotti discloses or suggests an acceptor device. Thus even if the alleged Official Notice assertions regarding the existence of means to allow input of media into an ATM were supported by the prior art, the Office has still not shown prior art evidence of the recited arrangement of an acceptor device with respect to a chest as recited in claim 24. For example, neither reference discloses or suggests a chest of an automated banking machine, which chest has a **generally "L" shaped outer contour**. In addition, neither references discloses or suggests that a shorter portion of the "L" shaped chest **includes an upper face with an opening therethrough**. Also, neither reference discloses or suggests that the acceptor device is **positioned above the shorter portion and is operative to move items through the opening**.

In addition, to not disclose or suggests these recited features regarding a chest and an acceptor device, Lee and Mariotti also do not disclose or suggest a deposit holding container. Further, neither reference discloses or suggests a deposit holding container **in removable connection within the shorter portion of the chest**. In addition, neither reference discloses or

suggests an acceptor device which is operative to move items through the opening in the upper face of the shorter portion and **into the container**.

The applied references do not disclose or suggest each of features and relationships recited in claim and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 24 is allowable for these reasons. Therefore it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is respectfully submitted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features, relationships, and/or steps that patentably distinguish the claimed invention over the applied art. Neither Lee nor Mariotti, taken alone or in combination, discloses or suggest the features, relationships, and/or steps that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features, relationships, and/or steps.

Additional Claim Fees


Please charge the fees associated with prosecution of one additional independent claim in excess of 3 (\$200) and three additional total claims in excess of 20 (\$150) and any other fee due, to Deposit Account No. 09-0428 of Diebold Self-Service Systems.

Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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